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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/693,415 | 10/20/2000 | Kia Silverbrook | NPA011US | 1266 |

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AUSTRALIA

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| EXAMINER |
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PHAM, THIERRY L

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| ART UNIT | PAPER NUMBER |
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2624

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 09/693,415 | Applicant(s) SILVERBROOK ET AL. | |
| | Examiner Thierry L. Pham | Art Unit 2624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-11,14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-11,14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 4/12/05.
- Claims 4-5, 12-13 have been canceled; Claims 1-3, 6-11, 14-15 are pending in application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 6, 8-9, 11, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman et al (U.S. 6330976), Ur (U.S. 6072871), and further in view of Markowitz (U.S. 5513254).

Regarding claim 1, Dymetman discloses a method of delivering a document directly to a user on demand (delivering digital documents directly to users in real-time basis, fig. 14-15, col. 19, lines 33-44, col. 28, lines 4-18, and col. 29, lines 28-38), said method comprising the steps of:

- formatting user requested information in the document (marking medium contains both coded data and human readable information, col. 7, lines 42-58 and col. 17, lines 35-40) so as to include one user interactive element (i.e. marking medium contains coded data which allows users to retrieve digital copy from remote system via using optical pointer 502, fig. 2), to allow the user to effect a response to the information, using a sensing device (optical pointer 502, fig. 2) for transmitting response back to a computer system (computer system, figs. 1-2;
- printing (col. 11, lines 55-60) the document, having advertising material in the advertising space (i.e. sales catalogue contains coded data which allows users to place an order by clicking on an item via using a pointer 502, col. 19, lines 33-42), together with coded data, said coded data being indicative of an identity of the document (identity of the document and zones within

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the coded marking medium, col. 3, lines 60-67 to col. 4, lines 1-23) and of the at least one interactive element.

Dymetman discloses a marking medium contains both coded data and human readable information (col. 14, lines 39-45, col. 35-39, and col. 19, lines 33-42) but fails to teach and/or suggest an inkjet printer prints the coded data at the same time as printing the document on the surface defining structure.

Ur, in the same field of endeavor for printing, teaches an ink jet printer (printer 17, fig. 1) prints the coded data at the same time as printing the document on the surface defining structure (prints coded data 27 and document texts as shown in fig. 2 at the same time, col. 4, lines 41-47).

However, the combinations Dymetman and Ur do not teach and/or suggest a method for identifying an advertising space outside an area of the document to be occupied by the information.

Markowitz, in the same field of endeavor for printing, teaches a method for identifying an advertising space outside (identifying an available white space within the document, fig. 4, abstract, col. 4, lines 45-57) an area of the document (i.e. below the text/graphic area, fig. 4c) to be occupied by the information.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Ur and Dymetman as per teaching of Markowitz because of a following reason: (1) a sensing device for sensing invisible coded data incorporated within the document (Dymetman, col. 12, lines 65-67); (2) printing an advertisement on an available white space of the document preventing an overlap between an advertisement and the document (3) reduce hardware costs and time by printing both coded data and document data simultaneously.

Therefore, it would have been obvious to combine Markowitz, Dymetman, and Ur to obtain the invention as specified in claims 1 & 9.

Regarding claims 3 & 11, Markowitz further discloses a method as claimed in claim 1 wherein the information is formatted at a publication server (fax server, fig. 3, col. 6, lines 1-54) of the computer system and the method includes the publication server monitoring the said area and, once the space is identified, receiving the advertising material from an advertising server (selecting advertisement from database, fig. 2, col. 6, lines 54), for including in the document.

Regarding claims 6 & 14, Dymetman further teaches a method as claimed in claim 5, which includes printing the coded data to be substantially invisible (col. 11, lines 45-50 and col. 12, lines 60-67) in the visible spectrum.

Regarding claim 8, Dymetman further teaches a method as claimed in claim 1, wherein the sensing device (reference 502, fig. 1-2, fig. 8) includes an identification code (network address, fig. 8, col. 9, lines 24-45) specific to a particular user and the method includes monitoring (server, col. 5, lines 10-36) of the sensing device in the computer system.

Claims 2, 7, 10, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz, Dymetman, and Ur as applied to claims 1 and/or 9 above, and further in view of Reiter (U.S. 6178411).

Regarding claims 2 & 10, the combinations of Markowitz, Dymetman, and Ur do not explicitly teach a method wherein the advertising space is determined to be on a reverse side of the document relative to the user requested information.

Reiter, in the same field of endeavor for advertising distribution, teaches a method wherein the advertising space is determined to be on a reverse side of the document relative to the user requested information (col. 2, lines 42-57 and col. 11, lines 1-4).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Markowitz, Dymetman, Ur as per teachings of Reiter because of a following reason: (1) printing advertisements/coupons on the back/reverse side of the document provides another option/way of distributing ads; therefore, increasing ads distribution flexibilities.

Therefore, it would have been obvious to combine Markowitz, Dymetman, Ur with Reiter to obtain the invention as specified in claims 2 & 10.

Regarding claims 7 & 15, Reiter further teaches retaining a retrievable record of the printed document (print report, col. 5, lines 50-67).

Response to Arguments

Applicant's arguments filed on 4/12/05 have been fully considered but they are not persuasive.

- Regarding claim 1, the applicants argued the cited prior art of record (US 6330976 to Dymetman) fails to teach and/or suggest a method of delivering document directly to a user on demand.

In response, the examiner notes that such newly added limitations were not cited in any previous pending claims. However, upon further consideration of cited prior art of record (US 6330976 to Dymetman), the examiner notes that Dymetman also teaches a method for delivering document directly to a user on demand (i.e. a digital copy of a document is displayed to a user via a computer monitor, figs. 14-15, in real-time basis, fig. 14-15, col. 17, lines 44-46, col. 19, lines 33-44, col. 28, lines 4-18, col. 28, lines 4-17 and col. 29, lines 28-38). In other words, marking medium as taught by Dymetman contains coded data, which allows users to directly access its digital contents via using a hand-held pointer as shown in fig. 9-10, for example, coded data can be an invisible URL and/or an identifier that links to a digital page stored on a server. Such digital page can be displayed (i.e. via a computer monitor) to a user interactively.

- Regarding claim 1, the applicants also argued the cited prior arts of record fail to teach and/or suggest delivering interactive documents directly to user's printer on demand is that coded data and document information should be printed at the same time at the user's printer.

In response, the examiner is unable to locate any limitations that correspond with the applicants' arguments. In other words, applicants are arguing subject matters that are not cited in claim 1.

- Regarding claim 1, the applicants also argued the cited prior arts of record fail to teach and/or suggest to utilize all the advantages of "online publications", which are regularly updated in "real-time" and Dymetman's system cannot deliver documents to user that are "current" at any given time.

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In response, the examiner is unable to locate any limitations that correspond with the applicants' arguments. In other words, applicants are arguing subject matters that are not cited in claim 1.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

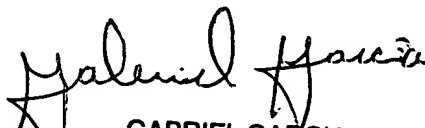
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 2727439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA
PRIMARY EXAMINER